

REMARKS/ARGUMENTS

Claims 1-3 and 6-19 are pending in this application. No claims have been added, amended, or cancelled with the filing of this response. Reconsideration is requested in view of the following remarks.

Claim Rejections under 35 U.S.C. § 103

The rejection of claims 1-3 and 6-19 under 35 U.S.C. § 103(a) as obvious over Gareiss et al. (US Patent No. 5,712,336) in view of Dvornic et al. (US Pat. Appl. Publication No. 2002/0161113) is traversed for at least the technical reasons presented of record. Applicants further traversed the rejection in view of the legal precedent provided below.

As the Board of Patent Appeal and Interferences has confirmed, an obviousness determination requires that the Office make “a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art.” *See In re Ward and Murphy*, Appeal No. 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original); *see also Ex parte Martin Haubner and Rolf Pinkos*, Appeal No. 2009-0449 (reversing an obviousness rejection and explaining that “in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of prima facie obviousness”). Moreover, the Supreme Court has indicated, *inter alia*, that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” and a “reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1731, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *see also Takeda Chem. Indus., v. Alphapharm Pty. Ltd.*, 492 F.3d 1350, 1356-57 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1731).

In the present case, Applicants point out that when the components of the present claims are compared to the disclosures of the references of record, including the recited structural features, it is evident that the claimed composition not only differs from the references there is no apparent reason that would have prompted a person of ordinary skill to combine the elements or modify the reference in the manner presently claimed.

In particular, as Applicants have pointed out, Gareiss et al. only, in a general sense, describes “thermoplastic polyesters” and not the separately

- A) from 10 to 99.99% by weight of at least one thermoplastic polyester; and
- B) from 0.01 to 50% by weight of a highly branched or hyperbranched A_xB_y polyester, as presently claimed.

For instance, Gareiss et al. describes an entire composition relating to flameproofed thermoplastic molding materials, in which the main material is a thermoplastic polyester.

When Gareiss et al. is considered in its entirety, there is no description or suggestion of all of above-described aspects or of the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (indicating that prior art references must be considered in their entirety, as a whole, including any disclosures that lead away from the claims at issue).

In particular, the reference provides several descriptions of thermoplastic polyesters, beginning at column 2. The reference also provides four other main components for the composition, including conventional additives. However, there is no such description or suggestion of the *separate* inclusion of a highly branched or hyperbranched A_xB_y polyester. According to the reference, the objects and benefits of the composition, e.g., improved flameproofing properties, are achieved based on the combination of components A) to C), *excluding* any highly branched or hyperbranched A_xB_y polyester.

Applicants note the Examiner’s assertion at page 24, paragraph 31 of the present Office Action, that Gareiss et al. is *open* to additives and modification by secondary references. However, Applicants assert, as pointed out above, that the Office must consider the reference in its entirety and provide some apparent reason, not merely a conclusory statement, that one would modify the reference in the manner alleged by the Office.

Moreover, even if one could modify Gareiss et al. in the manner presently claimed, Dvornic et al. still does not cure the deficiencies of the reference. In particular, as previously pointed out, Dvornic et al. clearly refers to the *synthesis* of general types of highly branched thermoplastic polymers, in which these polymers are compared to dendrimers. *Id.*, paragraph [0005] (emphasizing better theological properties, thermoplastic processing, etc.). Of the several generic hyperbranched polymers, there is no indication of the development of a composition

containing the polymers or any indication that one would modify/substitute the thermoplastic polymer of Gareiss et al. for a highly branched one.

Therefore, the rejection is improper and the present claims are novel and unobvious. Accordingly, reconsideration and withdrawal are requested.

Provisional Double Patenting Rejections

Applicants acknowledge the Office's indication that the provisional non-statutory double patenting rejections indicated on pages 6-23 of the present Office Action have been maintained. Applicants also acknowledge the Office's additional comments regarding the abeyance of these rejections, indicating that they cannot be suspended without persuasive comments the Office's indication at page 29, paragraph 29 of the present Office Action. However, Applicants respectfully point out that it is common patent practice to request that *provisional* double patent rejections be held in abeyance until allowable subject matter, especially where there may be ongoing prosecution in the co-pending patent applications. Accordingly, Applicants respectfully request that the rejections be held in abeyance.

In view of the above remarks, Applicants believe the pending application is in condition for allowance and notification of the same is kindly requested.

If additional fees are due with the filing of this response, please charge our Deposit Account No. 03-2775, under Order No. 12810-00333-US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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